

REMARKS

Reconsideration of the present application is respectfully requested.

Applicant has amended claims 1, 4, 5, 10, 14 and 18; and cancelled claims 6-9 and 21-24.

Note 3(b) of the Advisory Action.

In the continuation to Note 3(b) of the Advisory Action dated 9/5/2006, it is stated that with regards to “a folded gusset extending unbroken between said side walls” there is a possible issue of new matter, since it is not clear that applicant ever intended to preclude a “broken folded gusset.” Applicant respectfully disagrees that an unbroken folded gusset is new matter, and respectfully disagrees that the intention to preclude is the proper standard. The unbroken folded gusset is shown in the drawings, and is inherent in the original disclosure.

The CAFC established a standard for inherency in Kennecott Corp. v. Kyocera International, 5 USPQ2d 1194 (CAFC 1987). The court stated at page 1198:

“to prove inherency, the burden is on appellants to show that the ‘necessary and only reasonable construction to be given the disclosure by one skilled in the art’ is one which will lend clear support to . . . [this] positive limitation in the interference count”. . . . the court has generally applied this standard of the ‘necessary and only reasonable construction’ as a basis for determining whether an application could, on the basis of an inherent property, support a limitation in an interference count. . . . This standard, arising in the interference context, is consistent with that of the other cases on the issue of compliance with section 112, first paragraph.

This standard was repeated eleven years later by the CAFC when it overturned a rejection upheld by the BPAI in In re Daniels, 46 USPQ2d 1788 (CAFC 1998), where there CAFC stated at page 1790:

when the earlier disclosure is less than clear on its face, courts have explained that the prior application must “necessarily” have described the later claimed subject matter.

In this case, claim 10 includes an unbroken folded gusset which forms an unbroken spout for pouring contents. This construction is shown in Figs. 17, 19, 20, 21, and 22 as originally filed. The purpose of a spout is well known: a spout is a projecting tube or lip through or over which liquid can be poured from a container (Compact Oxford English Dictionary, 2nd edition, published 2003). It is also well known that a spout functions to minimize or eliminate spillage during pouring. However, putting a break in the spout would cause it to fail to perform properly – instead, the sides of the spout would flap and the fluid would spill from side to side because of the flexibility of the broken gussets on either side of the center of the spout. An unbroken spout is the necessary and only reasonable construction for the spout shown in the originally filed figures. Indeed, a broken spout would be unusual, and are unknown commercially. Unbroken spouts are the rule. In order for the spout to properly operate, it must be unbroken.

With regards to whether or not it is necessary to show an intention to preclude, applicant respectfully requests citation of statutory or case law in support of this premise.

Applicant respectfully requests entry of the specification and claim amendments shown herein.

The claim rejections under 35 U.S. C. §112.

Claim 9 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with a written description requirement.

Applicant cancels claim 9 without prejudice to its consideration in a continuing application, and further without admission that this claim fails to comply with the first paragraph of § 112.

Claim 1, 3-5, 9 and 17-20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Applicant has amended claim 1 to have proper antecedent basis and make it more definite. Applicant has cancelled claim 9.

With these amendments, Applicant has addressed these rejections under § 112, and withdrawal of these rejections is respectfully requested.

The rejections under 35 U.S.C. § 103.

Claims 1 and 3-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,325,543 to Ausnit and U.S. Patent No. 6,186,663 to Ausnit.

Applicant has amended claim 1 to include that the endstop obstructs movement of the slider past the second end, and also that the first and second profiles are higher than the top edge of the gusset. Applicant believes that a fair reading of Ausnit '543 does not disclose obstructing endstops of any kind, and further that Ausnit '663 does not disclose attaching the two profiles together by an endstop.

Applicant's amendment also addresses the comment in paragraph 6 regarding use of the word "proximate." Applicant has amended claim 1 to recite that the profiles are higher than the top edge of the gusset.

With regards to claim 18, Applicant has amended claim 18 to refer to the gusset having a topmost edge which is lower than either of the profiles.

As amended, claim 1 includes elements not found in the combination of Ausnit '543 and Ausnit '663. Since a *prima facie* case of obviousness cannot be established by these references, Applicant respectfully requests withdrawal of the rejection.

Applicant has cancelled claims 6-9 and 21-24 without prejudice to their consideration in a continuing application.

Claims 10-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,358,653 to Mock and '543 Ausnit.

Applicant has amended claim 10 to include that the folded gusset extends unbroken between sidewalls. Applicant believes a fair reading of Mock does not disclose such a feature. Reviewing the left side of FIG. 2 of Mock, it can be seen that there is a break between the sidewalls of Mock's bag, as evidenced by the internal details of Mock's bag that are visible through the break. Further, Applicant notes that nowhere does Mock disclose a folded gusset or a folded side. Further, Applicant notes that a broken left side as shown in FIG. 2 is consistent with the open view shown in FIG. 4 (i.e., the break of Mock permit the mouth to open more widely; therefore, Mock does not inherently have a folded gusset). Further yet, claim 10 includes a gusset that is folded, which is nowhere shown and described in Mock.

Applicant's unbroken gusset is shown in FIGS. 17, 19, 20, 21, and 22, as originally filed. Consistent with this original disclosure, Applicant has amended two paragraphs of the text of the specification to include the word "unbroken."

Lacking all elements of claim 10, the combination of Mock and Ausnit do not establish a *prima facie* case of obviousness. Applicant respectfully requests withdrawal of the rejection of claims 10-16.

CLOSING


Applicants have amended claims 1, 4, 5, 10, 14, and 18; and cancelled claim 6-9.

Applicant respectfully requests examination of pending claims 1, 3-5, and 10-20.

It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede any basis for rejections or objections in the Office Action. For those rejections based upon a combination of references and/or modification of references, there is no admission that the cited combinations are legally permitted, properly motivated, operable, or modifiable. Further, with regards to the various statements made in the Office Action concerning any prior art, the teachings of any prior art are to be interpreted under the law. Applicants make no admissions as to any prior art, except as explicitly stated. The remarks herein are provided simply to overcome the rejections and objections made in the Office Action in an expedient fashion.

The undersigned welcomes a telephonic interview with the Examiner if the Examiner believes that such an interview would facilitate resolution of any outstanding issues.

Respectfully submitted,

By: 

John V. Daniluck, Reg. No. 40,581
Bingham McHale LLP
10 West Market Street, #2700
Indianapolis, IN 46204
(317) 968-5529 – phone
(317) 236-9907 - fax